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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,460	06/26/2003	Nayan H. Joshi	ATOTP0104US	3492

7590 07/22/2005

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EXAMINER

CLEVELAND, MICHAEL B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/606,460	Applicant(s) JOSHI ET AL.	
	Examiner Michael Cleveland	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The rejections of claims 68-70 over Wernick.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 28-31, 36-42, 50-52, 54-63 and 65-72.
Claim(s) withdrawn from consideration: 53 and 64.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: PTO-892.


Michael Cleveland
Primary Examiner
Art Unit: 1762

DETAILED ACTION

1. The proposed After Final amendment will be entered upon timely filing of an Appeal Brief in support of a timely-filed Notice of Appeal. The rejections of claims 32-35 and 43-45 would be rendered moot by the amendment. The rejections of claims 68-70 over Wernick are withdrawn. All other claims would remain rejected under the current grounds.

Response to Arguments

2. Applicant's arguments filed 7/11/2005 have been fully considered but they are not persuasive.

Applicant's remarks regarding the term "immersion plating" in contrast to "electroplating" (and "electroless plating") are noted. The Examiner acknowledges that there is a technique called "displacement plating", which is also known as "immersion plating" (See, e.g., Tsuji et al. (U.S. Patent 5,234,574, col. 1, lines 31-40), which proceeds via a galvanic displacement. It is recommended that, in future applications, Applicant choose the non-ambiguous language "displacement plating" instead of "immersion plating", which on its face, appears to be inclusive of any of electroplating, displacement plating, and electroless plating.

Applicant's remark that the term "electroplating" is completely distinct from "immersion plating" is found to be imprecise because electroplating may include immersion plating (See, e.g., Kowalski (U.S. Patent 3,928,147, col. 1, lines 27-39) and because displacement plating is a species of electroplating (See, e.g., Young, U.S. Patent 4,686,017, Abstract, and the classification schedule of class 205, which includes the subclasses

80 ELECTROLYTIC COATING (PROCESS, COMPOSITION AND METHOD OF PREPARING COMPOSITION)

- 81 . Involving measuring, analyzing, or testing
- 82 .. Controlling coating process in response to measured or detected parameter
- 83 ... Parameter is current, current density, or voltage
- 84 ... Parameter is thickness, weight, or composition of coating
- 85 . **Displacement or replacement coating**).

Applicant argues that the claims are limited to an immersion plating process. The argument is unconvincing because the claims do not positively recite immersion plating (or

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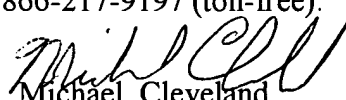
displacement plating) but instead require immersing the substrate in an immersion plating solution. Thus, the claims require only that the solution be capable of immersion plating. The solution suggested by Eckles and Suzuki either must be capable of such use because they contain the same components as in Applicant's claims or else such ability results from essential features which are not present in the claims.

Applicant's arguments that claims 68-70 are not anticipated by Wernick because they depend from claim 60 is convincing, and the rejections of claims 68-70 would be withdrawn. The rejections of claims 32-35 and 43-45 over Wernick would be withdrawn upon entry of the proposed amendment for this reason and because the proposed amendment would cancel claims 32-35 and 43-45.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Cleveland
Primary Examiner
Art Unit 1762

7/19/2005